

REMARKS

This is intended as a full and complete response to the Office Action dated January 10, 2006, having a shortened statutory period for response set to expire on April 10, 2006. Claims 1-44 remain pending in the application. Please reconsider the claims pending in the application for reasons discussed below.

Claim Rejections Under 35 U.S.C. § 112

The Examiner rejected claims 12-21 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In response, Applicants have amended claims 12-21 accordingly. More specifically, Applicants have amended the preamble of claims 12-21 to state "a signal bearing media containing a program..." as described in paragraph [0058] and other paragraphs in the published application. Applicants respectfully request the rejection of claims 12-21 be removed and allowance of the same.

Specification

The Examiner stated that trademarks in the specification have been noted and should be capitalized wherever it appears. In response, Applicants have amended the specification accordingly.

Additionally, Applicants note that paragraph [0049] in the published application states "the sever node 3084" which should be "the server node 3084" as indicated on page 14 of the filed application.

Claim Rejections Under 35 U.S.C. § 102(b)

The Examiner rejected claims 1, 32, 41, and 43 as being anticipated by *Mullins* '156. In response, Applicants have amended claims 1 and 32. Additionally, Applicants have cancelled claims 41 and 43.

As amended, claim 1 includes the limitations of lowering the modular downhole tool into a wellbore as a unit, the downhole tool including a server node and a plurality of secondary nodes, detecting, by the server node, the presence of each secondary

node and removing the modular downhole tool from the wellbore as a unit. As amended, claim 32 includes the limitation of a downhole tool that is configured as an integral unit such that the downhole tool is lowered into a wellbore as a unit and removed from the wellbore as a unit. *Mullins* does not disclose these limitations. In contrast, *Mullins* merely discloses a control sub "14" and a diagnostic sub "13", whereby the control sub "14" is lowered and permanently installed in the wellbore. Subsequently, the diagnostic sub "13" is lowered into the wellbore to perform tests on the control sub "14" and then removed from the wellbore. (See *Mullins*, col. 6, lines 55-60) The diagnostic sub "13" disclosed in *Mullins* contains all the necessary interface and charging system to test the control sub "14".

As the foregoing illustrates, *Mullins* fails to teach or disclose all the limitations of claims 1 and 32. This failure precludes *Mullins* from anticipating claims 1 and 32. Therefore, Applicants respectfully request the 102(b) rejection of claims 1 and 32 be removed and allowance of the same. Additionally, claims 2, 5, 6, 8, and 10-11 depend from claim 1 and claims 14, 17, 18, and 20 depend from claim 12 and these claims are allowable for at least the same reasons as claims 1 and 12.

The Examiner rejected claim 22 as being anticipated by *Tubel*. In response, Applicants have amended claim 22.

As amended, claim 22 includes the limitation of a server node and a plurality of secondary nodes that are located in different modules of a modular drilling tool. *Tubel* does not disclose this limitation. In contrast, *Tubel* discloses a server "400" disposed at the surface of a wellbore that controls a plurality downhole control systems via a network "410". (See *Tubel*, col. 20, lines 15-35 and Figure 9) Moreover, contrary to an assertion by the Examiner, *Tubel* does not disclose a drilling tool. Rather, *Tubel* merely discloses a control systems network disposed in a wellbore after the formation of the wellbore.

As the foregoing illustrates, *Tubel* fails to teach or disclose all the limitations of claim 22. This failure precludes *Tubel* from anticipating claim 22. Therefore, Applicants respectfully request the 102(b) rejection of claim 22 be removed and allowance of the same. Additionally, claims 2, 5, 6, 8, and 10-11 depend from claim 1 and claims 23-25,

27, and 29-31 depend from claim 22 and claims 33 and 36-40 depend from claim 32 and these claims are allowable for at least the same reasons as claims 1, 22, and 32.

Claim Rejections Under 35 U.S.C. § 103(a)

The Examiner rejected claims 3, 4, 7, 9, 15, 16, 19, 21, 42, and 44 as being unpatentable over *Mullins* as applied to claim 1 above, and further in view of *Tubel*. The Examiner admits that *Mullins* does not disclose a server node for transmitting a wake-up signal to each of the secondary nodes and receiving an acknowledgement from each module. As such, the Examiner attempts to supplement this missing limitation with *Tubel*. According to the Examiner, it would have been obvious to one of ordinary skill in the art to modify the system of *Mullins* to include transmitting a wake-up signal to each of the secondary nodes and receiving an acknowledgement from each module as taught by *Tubel* since *Mullins* suggests this limitation because this is done when running a diagnostic test.

Applicants respectfully traverse the rejection on grounds that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the Examiner must *particularly* identify any suggestion, teaching or motivation from *within* the references to combine the references (emphasis added). See *In Re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). The mere recitation that *Mullins* suggests transmitting a wake-up signal to each of the secondary nodes and receiving an acknowledgement from each module because this is done when running a diagnostic test does not amount to particularly identifying a suggestion, teaching, or a motivation to combine the references. Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Moreover, the teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not in the applicants' disclosure. See M.P.E.P. § 2143, citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

As set forth above, the Examiner failed to establish a *prima facie* case of obviousness. As a result, the combination of *Mullins* and *Tubel* fails to render claims 3,

4, 7, 9, 15, 16, 19, 21, 42, and 44 obvious. Applicants therefore submit that claims 3, 4, 7, 9, 15, 16, 19, 21, 42, and 44 are in condition for allowance and respectfully request withdrawal of the § 103(a) rejection.

The Examiner rejected claims 26, 28, 34, and 35 under 35 U.S.C. § 103(a) as being unpatentable over *Tubel*. Applicants have cancelled claim 26. Further, Applicants respectfully traverse the rejection of claims 28, 34, and 35. Claim 28 depends from claim 22 and as set forth above, *Tubel* fails to teach or suggest all the limitations of claim 22. Additionally, claims 34 and 35 depend from claim 32 and includes the limitation of a downhole tool that is configured as an integral unit such that the downhole tool is lowered into a wellbore as a unit and removed from the wellbore as a unit. *Tubel* fails to disclose this limitation. For these reasons, *Tubel* fails to render claims 28, 34, and 35 obvious. Applicants therefore submit that claims 28, 34, and 35 are in condition for allowance and respectfully request withdrawal of the § 103(a) rejection.

New Claims

New claims 45-52 were added to claim aspects of the present invention. Applicants submit that no new matter was added. Claims 45 and 46 depend from claim 1 and these claims are allowable for at least the same reasons as claim 1. Additionally, Applicants believe that *Mullins* and/or *Tubel* fails to disclose a method for configuring and communicating between a server node and a plurality of secondary nodes disposed on a modular downhole tool, comprising lowering the modular downhole tool into a wellbore as a unit, detecting the presence of the plurality of secondary nodes by employing the sever node, transmitting information received from at least one of the plurality of nodes to a remote location external to the downhole tool, performing a downhole operation by utilizing the downhole tool, and removing the modular downhole tool from the wellbore as a unit, as recited in new claims 47-51. Furthermore, Applicants believe that *Mullins* and/or *Tubel* fails to disclose method for drilling a wellbore, comprising lowering a modular drilling tool into the wellbore, the modular drilling tool including a server node and a plurality of secondary nodes, detecting the

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presence of the plurality of secondary nodes by employing the sever node, issuing a control signal from the server node to at least one of the plurality of secondary nodes, and drilling the wellbore, as recited in new claim 52. Applicants therefore believe that new claims 45-52 are in condition for allowance and respectfully request the same.

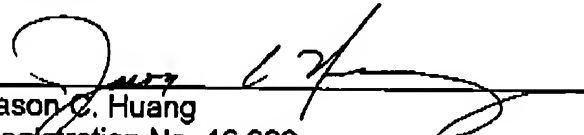
Information Disclosure Statement

An information disclosure statement and a PTO Form 1449 were filed on May 7, 2002. Applicants respectfully request the Examiner to consider the references listed on the PTO Form 1449. For convenience, Applicants have attached a copy of the PTO Form 1449 filed on May 7, 2002.

Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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